

REMARKS

Applicant respectfully requests reconsideration of the application.

In the Action of September 9, 2004, the Office noted that Applicant must file items required under 37 C.F.R. 1.608(b) as explained in MPEP 2308.01 on the basis that the effective filing date of the application is March 30, 2000, which is more than three months after the effective filing date of the patent (U.S. Patent 5,889,868, filed July 2, 1996) involved in the potential interference.

However, as noted by the Examiner in the Action dated December 23, 2003, the effective date of the application is at least as early as April 25, 1996. Therefore, since the effective filing date of this application is earlier than the effective filing date of the '868 patent, Applicant respectfully submits that 37 C.F.R. 1.608(b) does not apply.

In Applicant's 607 Request filed with the application, Applicant indicated that 37 C.F.R. 1.608 is irrelevant since the effective filing date of this application precedes the effective filing date of the '868 patent. See page 16 of the 607 Request. The basis for this position is set forth in the request for benefit on pages 15-16 of the 607 Request, which outlines the priority claim originally filed with the application.

Applicant requests benefit of filing dates that precede the April 25, 1996 priority application. As shown below, the effective date of several of the claims in the application is at least as early as October 21, 1994, the filing date of priority application 08/327,426. In response to the 12/23/03 Action, Applicant amended the priority claim to clarify the relationship among the applications in the chain of priority. Applicant also overcame the Office's rejections under Section 112 by establishing the support in the specification for the claims at issue. As a guide to the Examiner, Applicant has prepared a table accompanying this response showing that the support identified in the specification has an effective date at least as early as October 21, 1994, for many claims, and is no later than April 25, 1996, the filing date of priority application 08/637,531. In particular, the priority of claims 11-14, 16 and 63-68 is at least as early as October 21, 1994, and is no later than May 8, 1995, the filing date of priority application 08/436,102. In addition, the priority of claims 20-22 is at least as early as April 25, 1996, and is no later than this date.

The application at issue is a continuation of application 09/186,962, filed November 5, 1998, and includes the same subject matter of the '962 application. The '962 application is a continuation of application 08/649,419, filed May 16, 1996 (now Patent 5,862,260), and includes the same subject matter of the '419 application. The '419 application is a continuation-in-part of: application 08/637,531, filed April 25, 1996 (now Patent 5,822,436). The '531 application includes all of the subject matter that has been cited thus far as support for the claims at issue.

The '419 is also a continuation in part of application 08/436,102, filed May 8, 1995 (now patent 5,748,783). The '102 application includes all of the subject matter cited thus far as support for claims 11-14, 16 and 63-68. It also includes the subject matter cited from the earlier applications in the priority claim. See accompanying priority table.

The '419 is also a continuation in part of application 08/327,426, filed October 21, 1994 (now patent 5,768,426). The '426 application includes subject matter cited as supporting claims 11-14, 16 and 63-68 as shown on the accompanying priority table. It also includes the subject matter cited from the earlier applications in the priority claim.

Application 08/327,426 is a continuation in part of application 08/215,289, filed March 17, 1994 (now abandoned). The '289 application, as described further below, provides support for claims 20-22. It also includes the subject matter cited from the earlier application (the '866 application) in the priority claim.

The priority date of claims 20-22 should be at least March 17, 1994, the filing date of priority application 08/215,289, which describes a form of spread spectrum technique for encoding watermarks. In particular, this priority application, which forms part of the application at issue, describes such spread spectrum techniques as follows:

1. A method of generating pseudorandom code signals. See, for example, "individual embedded code signals" described at page 6, lines 19-25 of the '289 application (current specification at page 7, lines 3-8);
2. Modulating the polarity of these pseudo random codes signals to convey binary bit values of an identification word. See, for example, use of polarity in creating a composite embedded code signal at page 15, line 27 to page 16, line 13 of the '289 application (current specification at page 16, line 22, to page 17, line 7).

3. Embedding the result in a signal. See page 7, lines 15-20, and Fig. 2 of the '289 application (current specification at page 7, line 27 to page 8, line 2).

4. Decoding using a spread spectrum technique such as cross correlating with the pseudorandom embedded code signals to ascertain the bit values of bits in the identification word. See, for example, page 8, line 16 to page 9, line 6 (current specification at page 8, line 28, to page 9, line 18.

These techniques, which are described in the current application and each of the priority applications at least back to the '289 application, are a form of spread spectrum technique in that the bit values of a digital watermark message are spread over a pseudorandom code signal by modulating the polarity of the code signal. These bit values are demodulated by cross correlating with the pseudo random code signals.

The undersigned attorney for Applicant requests a telephone interview with the undersigned Attorney for Applicant (Joel Meyer at 503 469-4655) to discuss the case, and in particular, to discuss the priority date that should be afforded each of the claims.

Date: January 10, 2005

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Respectfully submitted,

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By



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Claim	Reference to Specification in May 14, 2004 Response, Claim Chart submitted with the application for claims 11-14, 16, and 20-22, and claim chart submitted on December 26, 2002, for claims 63-68	Location in Priority documents
11	page 7, lines 9-13	Application 08/154,866, filed November 18, 1993, at page 5, lines 33-38.
11	page 23, line 16	Application 08/327,426, filed October 21, 1994 (now patent 5,768,426), at page 34, line 15.
11	page 30, lines 15-19	'426 Application at page 43, lines 22-30.
11	page 39, line 21	'426 Application at page 56, line 20.
11	page 46, line 3	'426 Application at page 66, line 3.
11	page 61, lines 2-17	Application 08/436,102, filed May 8, 1995 (now patent 5,748,783) at page 49, lines 1-14.
12	page 7, lines 9-13	'866 Application at page 5, lines 33-38.
	page 31, lines 24-30	'426 Application at page 45, lines 18-30.
	page 61, lines 2-17	'102 Application at page 49, lines 1-14.
13	Same citations as claim 12.	
14	Same citations as claim 12.	
16	page 10, lines 26-31	'866 Application at page 9, lines 15-23
16	page 11, lines 8-17	'866 Application at page 9, line 33 – page 10, line 6.
16	page 30, line 16	'426 Application at page 43, lines 24-25 (algorithmic noise generator seeded with a known key number).
	page 39, line 21	'426 Application at page 56, line 20.
	page 61	'102 Application at page 49.
20	page 116, lines 13-23	Application 08/637,531 at page 7, line 26 – page 8, line

		7.
21	page 116, lines 6-11	'531 Application at page 7, lines 19-24.
	page 116, lines 13-23	'531 Application at page 7, line 26 – page 8, line 7.
22	Same citations as claim 21	
63	Fig. 6	Fig. 6 of '426 Application
	page 33, lines 10-13	'426 Application at page 47, lines 32-37.
	page 23, line 21 – page 24, line 29	'426 Application at page 34, line 21 – page 36, line 16.
	page 32, lines 3-16	'426 Application at page 45, line 34 – page 46, line 21.
	page 30, line 16	'426 Application at page 43, lines 24-25 (algorithmic noise generator seeded with a known key number).
	page 39, line 21	'426 Application at page 56, line 20.
	page 61	'102 Application at page 49.
64	page 34, lines 13-24	'426 Application at page 49, lines 11-32.
	Same citations as claim 63.	
65	page 10, lines 3-9	'866 Application at page 8, lines 27-35.
	Same citations as claim 63.	
66	Page 30, lines 15-19	'426 Application at page 43, lines 22-30.
	Same citations as claim 63	
67	Page 34, lines 13-24	'426 Application at page 49, lines 11-32.
	Same citations as claim 63	
68	Page 10, lines 3-9	'866 Application at page 8, lines 27-35
	Same citations as claim 63	